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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/814,241      | 03/21/2001  | Shoichi Miyamoto     | FUJx 18.462         | 2021             |

26304 7590 05/05/2004

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575 MADISON AVENUE  
NEW YORK, NY 10022-2585

EXAMINER

PHU, SANH D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2682

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/814,241

Applicant(s)

MIYAMOTO ET AL.

Examiner

Sanh D Phu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03/21/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

DETAILED ACTION

*Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 28-31, drawn to a mobile communication system, classified in class 455, subclass 422.1.
- II. Claims 1-13, drawn to a base station control equipment for call routing, classified in class 455, subclass 445.
- III. Claims 14-23, drawn to a radio base station equipment, classified in class 455, subclass 561.
- IV. Claims 24-27, drawn to a radio terminal equipment for channel allocation for a call, classified in class 455, subclass 450.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions [I] and [II] are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the

combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because at least the omission of a function of channel controlling which executes, in cooperation with a plurality N of radio base stations, channel control of a call occurring in a mobile station located in any of wireless zones individually formed by said radio base stations, as claimed in claims 1-12 in group II, or the omission of a function of channel controlling which forming a new visit zone of a mobile station and allotting a downstream communication channel, that is formed between a mobile station and a radio station, to the radio base station which executes transmission power control of a down stream speech signal to be transmitted to the mobile station according to a signal received from the mobile station, as claimed in claim 13 in group II, is evidence that the patentability of the invention claimed in group I does not rely on the details of such functions of channel controlling. The subcombination has separate utility such as speech path forming means,

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as recited in claims 1-12 in group II, or channel allotting means, as recited in claim 13 in group II, which are not recited in group I.

3. Inventions [I] and [III] are related as combination and subcombination.

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because at least the omission of a function of channel controlling which executes channel control relating to a wireless zone under the initiative of and in cooperation with a base station controller, as claimed in claims 14 and 18-21 in group III, or the omission of a function of channel controlling which terminates updating of a transmitting power either at a time point after a predetermined period from the initiation of transmission of a communication channel or at a time point at which transmission power of said communication channel reaches a predetermined value, before the initiation of a transmitting power control according to a signal received from a mobile station, as claimed in claim 23 in group III, is evidence that the patentability of the invention claimed in group I does not reply on the details of such functions of channel controlling. The subcombination has separate utility such as wireless interfacing means, as recited in claims 14 and

18-21 in group III, or a combination of a transmitting power controlling means and channel control means, as recited in claim 22 in group III, which are not recited in group I.

4. Inventions [I] and [IV] are related as combination and subcombination.

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because at least the omission of a function of channel controlling which monitors transmission quality of a downlink in a new visit-zone during a period where a completed call occurring in a local station continues to exist and transmits a response to a base station forming the new visit-zone among plurality of radio base stations through wireless interface means when said transmission quality is below a predetermined threshold value, as recited in claims 24 and 25 in group IV, the omission of a function of channel controlling which monitors transmission quality of a downlink in a new visit-zone during a period where a completed call occurring in a local station continues to exist and notifies the transmission quality to a radio base station forming a former visit zone among a plurality of radio base stations, as recited in claim 26 in group IV, or the omission of a

function of channel controlling which obtains a transmission rate of transmission information to be received through a down link in a wireless zone wherein a local station is located, when a completed call occurs in the local station or while a complete call continues to exist, and notifies the transmission rate to a radio base station forming said wireless zone, as recited in claim 27 in group IV. The subcombination has separate utility such as wireless interfacing means, as recited in claims 24-27 in group IV, which is not recited in group I.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. A telephone call was made to Mr. Samson Helfgott on 04/19/2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanh D Phu whose telephone number is (703) 305-8635. The examiner can normally be reached on 8:00-16:30.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Sanh D. Phu  
Examiner  
Art Unit 2682

SP



VIVIAN CHIN  
SUPERVISORY PATENT EXAMINER  
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4/30/04